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6 IN THE UNITED STATES DISTRICT COURT

7 FOR THE NORTHERN DISTRICT OF CALIFORNIA

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10 TYCO HEALTHCARE GROUP LP d/b/a
VNUS MEDICAL TECHNOLOGIES

No. C-08-3129 MMC

11 Plaintiff

**ORDER DENYING DEFENDANTS'
MOTION FOR SUMMARY JUDGMENT
THAT ASSERTED '433 AND '970
CLAIMS ARE INVALID FOR LACK OF
WRITTEN DESCRIPTION**

12 v.

13 BIOLITEC, INC., et al.,

14 Defendants

15 /

16 Before the Court is defendants "Motion for Summary Judgment that the Asserted
17 '433 and '970 Claims are Invalid for Lack of Written Description," filed June 25, 2010.
18 Plaintiff Tyco Healthcare Group LP has filed opposition, to which defendants have replied.
19 Having read and considered the papers filed in support of and in opposition to the motion,
20 the Court rules as follows.¹

21 **BACKGROUND**

22 In the instant action, plaintiff alleges defendants have infringed the claims of U.S.
23 Patent Nos. 6,769,433 ("433 Patent") and 7,406,970 ("970 Patent"). By the instant motion,
24 defendants argue they are entitled to summary judgment on their respective counterclaims
25 that Claims 1, 2, and 10 of the '433 Patent and Claims 1, 2, 3, 8, 9, 13, 15, 17, 19 and 20 of
26 the '970 Patent are invalid for failure to satisfy the written description requirement in 35
27 U.S.C. § 112.

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1By a Clerk's notice filed July 22, 2010, the matter was taken under submission.

1 Claim 1 of the '433 Patent is an independent claim that claims a "method of applying
2 energy to a vein to cause the vein to durably assume a reduced diameter," specifically, a
3 method comprising the following steps: (1) "introducing a catheter having a working end
4 into a vein having an inner wall"; (2) "pre-shaping the vein such that the inner wall of the
5 vein is brought toward the working end of the catheter so as to reduce the diameter of the
6 vein"; (3) "applying energy from the working end of the catheter to the vein so as to cause
7 the vein to durably assume a diameter of at least as small as the reduced diameter
8 achieved in the step of pre-shaping the inner wall of the vein toward the working end of the
9 catheter"; and (4) "moving the catheter along the vein during the step of applying energy."
10 See '433 Patent, col. 19, ll. 15-30. Claim 2 of the '433 Patent claims the method of Claim 1
11 with the additional limitation that "a lengthy occlusion is formed along the area of the vein in
12 which the catheter is moved." See '433 Patent, col. 19, ll. 31-33. Claim 10 of the '433
13 Patent claims the method of Claim 1 with the additional limitation that the "energy" that is
14 applied is "light energy." See '433 Patent, col. 19, ll. 50-51.

15 Claim 1 of the '970 Patent is an independent claim that claims a "method of treating
16 venous insufficiency," specifically, a method comprising the following steps: (1)
17 "introducing an elongate member into a vein having an inner wall"; (2) "flattening the vein
18 such that the inner wall of the vein is brought toward a distal region of the elongate
19 member"; (3) "applying energy from the distal region of the elongate member to the vein to
20 create a thermal effect in the vein so as to reduce the diameter of the vein and lead to
21 occlusion of the vein"; and (4) "retracting the elongate member along the vein during the
22 step of applying energy." See '970 Patent, col. 18, ll. 53-64. Claim 2 of the '970 Patent
23 claims the method of Claim 1 with the additional limitation that "a lengthy occlusion is
24 formed along the area of the vein in which the elongate member is retracted during the step
25 of applying energy." See '970 Patent, col. 18, ll. 65-68. Claim 3 of the '970 Patent claims
26 the method of Claim 1 with an additional step, specifically, "delivering fluid to the vein
27 where the distal region of the elongate member is located." See '970 Patent, col. 19, ll. 1-
28 3. Claim 8 of the '970 Patent claims the method of Claim 1 with the additional limitation

1 that the “energy” applied is “light energy.” See ‘970 Patent, col. 19, ll. 9-11. Claim 9 claims
 2 the method of claim 8 with the additional limitations that the “elongate member” is “a fiber
 3 optic” and that the “light energy” is applied with “the fiber optic.” See ‘970 Patent, col. 19, ll.
 4 16-17. Claim 13 of the ‘970 Patent claims the method of Claim 1 with the additional
 5 limitation that the “flattening” step includes the step of “compressing the anatomy
 6 surrounding the vein at the location of the distal region of the elongate member.” See ‘970
 7 Patent, col. 19, ll. 28-31.

8 Claim 15 of the ‘970 Patent is an independent claim that claims a “method of treating
 9 venous insufficiency,” specifically, a method comprising the following steps:
 10 (1) “introducing an elongate member having an axis into a vein having an inner wall”;
 11 (2) “moving the inner wall of the vein toward the axis of the elongate member at a distal
 12 region of the elongate member, independently of the elongate member”; (3) “applying
 13 energy from the distal region of the elongate member to the vein to create a thermal effect
 14 in the vein so as to reduce the diameter of the vein and lead to occlusion of the vein”; and
 15 (4) “retracting the elongate member along the vein during the step of applying energy to
 16 form an occlusion along the area of the vein where the elongate member is retracted during
 17 the step of applying energy.” See ‘970 Patent, col. 20, ll. 3-17. Claim 17 of the ‘970 Patent
 18 claims the method of Claim 15 with the additional limitation that the “moving” step includes
 19 the step of “compressing the anatomy surrounding the vein at the location of the distal
 20 region of the elongate member.” See ‘970 Patent, col. 20, ll. 21-24. Claim 19 of the ‘970
 21 Patent claims the method of Claim 15 with the additional limitation that the energy applied
 22 is “light energy.” See ‘970 Patent, col. 28-29. Claim 20 of the ‘970 Patent claims the
 23 method of claim 19 with the additional limitations that the “elongate member” is “a fiber
 24 optic” and that the “light energy” is applied with “the fiber optic.” See ‘970 Patent, col. 20, ll.
 25 30-32.

26 The specifications of the ‘433 and ‘970 Patents are identical to each other, and each
 27 is identical to the 1997 application from which both patents are derived. (See Steenburg
 28 Decl. Ex. 58.)

DISCUSSION

Section 112 provides that a “specification shall contain a written description of the invention.” See 35 U.S.C. § 112, ¶ 1. “Adequate written description means that the applicant, in the specification, must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the claimed invention.” Agilent Technologies, Inc. v. Affymetrix, Inc., 567 F.3d 1366, 1379 (Fed. Cir. 2009) (internal quotation, citation and alteration omitted). Stated otherwise, the specification “considered as a whole must convey to one of ordinary skill in the art, either explicitly or inherently, that [the inventor] invented the subject matter claimed in the [] patent.” See Reiffin v. Microsoft Corp., 214 F.3d 1342, 1346 (Fed. Cir. 2000). “[W]hatever the specific articulation, the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co., 598 F.3d 1336, 1351 (2010). “[C]ompliance with the ‘written description’ requirement of § 112 is a question of fact.” Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563 (Fed. Cir. 1991).

Because patents are presumed valid, a party seeking to invalidate a patent by summary judgment must demonstrate it is undisputed that “clear and convincing evidence” exists to establish the inventor did not comply with the written description requirement, see ICU Medical, Inc. v. Alaris Medical Systems, Inc., 558 F.3d 1368, 1376 (Fed. Cir. 2009), specifically, that no trier of fact could reasonably find the specification “conveyed with reasonable clarity to those of ordinary skill in the art that [the inventor] has in fact invented the [invention] recited in [the] claims,” see Vas-Cath, 935 F.2d at 1567 (reversing order granting summary judgment of invalidity for failure to comply with written description requirement in light of triable issues of fact).

As noted, defendants argue that three claims of the '433 Patent and ten claims of the '970 Patent are invalid for failure to comply with the written description requirement. In their motion, defendants characterize plaintiff's infringement contentions as follows: "[Plaintiff] alleges that defendants indirectly infringe the '433 and '970 claims when, *inter*

1 *alia*, they sell single fiber optic lines that doctors place inside veins and use to apply laser
2 energy. [Plaintiff] focuses particular attention on ordinary bare-tip laser fibers” (See
3 Defs.’ Mot. at 2:25-28 (internal citation omitted).) With respect to the issue of invalidity,
4 defendants argue the subject claims are “invalid because a person of ordinary skill in the
5 art reading the September 1997 application on which the patents are based would not
6 understand the invention to include applying energy to veins by means of a single bare-tip
7 fiber.” (See *id.* at 3:12-14 (internal citation omitted).) In other words, defendants’ theory is
8 that a person of ordinary skill in the art, having read the specification, would not understand
9 the applicant to have invented a method of applying energy to veins in the manner
10 employed by the accused products, specifically, a single bare-tip fiber, and, consequently,
11 the subject claims are invalid.

12 As plaintiff correctly notes, the Federal Circuit has held that “[t]he invention is, for
13 purposes of the ‘written description’ inquiry, whatever is now claimed [in the patent].” See
14 *Vas-Cath*, 935 F.2d at 1664 (emphasis in original). Consequently, for purposes of the
15 written description requirement, the issue is not whether a specification provides an
16 adequate description of an accused product, but, rather, whether the specification provides
17 an adequate description of the claimed invention. For example, in *Moba, B.V. v. Diamond*
18 *Automation, Inc.*, 325 F.3d 1306 (Fed. Cir. 2003), where the plaintiff had alleged
19 defendant’s customers infringed plaintiff’s claimed method for “lifting eggs” when those
20 customers used defendant’s “moving conveyor,” the Federal Circuit found unpersuasive
21 defendant’s “contention that the [subject] patent does not adequately disclose lifting eggs
22 from a moving conveyor,” for the reason that such argument “merely revive[d] its non-
23 infringement argument in the cloak of a validity challenge.” See *id.* at 1321 (affirming jury’s
24 finding that patent claiming method to lift eggs was “not invalid for lack of an adequate
25 written description”); see also, e.g., *Inline Connection Corp. v. Earthlink, Inc.*, 684 F. Supp.
26 2d 496, 528, 531 (D. Del. 2010) (holding “written description analysis examines whether the
27 inventor possessed the claimed invention, not whether he possessed or invented the
28 accused technology”; rejecting defendant’s arguments that claims were invalid because

1 specification did not "teach anything" about defendant's accused product).

2 The cases on which defendants rely address whether a particular claim element is
 3 adequately described in the specification. See, e.g., PowerOasis, Inc. v. T-Mobile USA,
 4 Inc., 522 F.3d 1299, 1307-11 (Fed. Cir. 2008) (determining whether specification
 5 adequately described claimed "customer interface" element). Here, by contrast,
 6 defendants fail to identify any particular claim element(s) not adequately disclosed. Rather,
 7 as discussed above, defendants argue that the specification does not disclose use of
 8 "single bare-tipped fiber." None of the claims of the '433 or the '970 Patents, however,
 9 include a limitation requiring the person performing the method use a "single bare-tipped
 10 fiber" to apply energy. Consequently, defendant's argument is misplaced, at least when
 11 raised in support of a contention that the claims are invalid for lack of an adequate written
 12 description. See Phillips Petroleum Co. v. United States Steel Corp., 673 F. Supp. 1278,
 13 1290-91 (D. Del. 1987) (rejecting defendant's argument that patent inventing "crystalline
 14 polypropylene" molecules was invalid for failure to "describe" molecules with particular
 15 viscosity and weight of accused products; noting claims did not "contain[] a limitation
 16 regarding intrinsic viscosity or molecular weight," and, consequently, defendant's
 17 contentions were "immaterial" with respect to whether claims were adequately described),
 18 aff'd, 865 F.2d 1247, 1251-52 (Fed. Cir. 1989) (affirming district court; characterizing
 19 defendant's argument as "relat[ing] to infringement, not to patentability").

20 Accordingly, defendant has not shown it is undisputed that Claims 1, 2, and 10 of the
 21 '433 Patent and Claims 1, 2, 3, 8, 9, 13, 15, 17, 19 and 20 of the '970 Patent, or any of
 22 them, are invalid for failure to satisfy the written description requirement.

23 **CONCLUSION**

24 For the reasons stated above, defendants' the motion is hereby DENIED.

25 **IT IS SO ORDERED.**

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 27 Dated: August 3, 2010
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 MAXINE M. CHESNEY
 United States District Judge